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Dated: 7/10, 2003

Signature: Kathryn L. Nash
(Kathryn L. Nash)

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7-24-03
11/APPEAL
BRIEF

Docket No.: 65043-0038
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
John M. Shanahan

Application No.: 09/888,145

Group Art Unit: 3711

Filed: June 22, 2001

Examiner: V. Mendiratta

For: A CARD GAME WITH PREDETERMINED
HANDS IN A FORTUNE COOKIE

BRIEF PURSUANT TO 37 C.F.R. §1.192

ON BEHALF OF APPELLANT

John M. Shanahan

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Dear Sir:

This is an Appeal Brief under Rule 192 (transmitted in triplicate), appealing the Final Office Action of the Examiner mailed on December 12, 2002 (paper no. 5). All fees required under §1.17(f) and any required fee for extension of time for filing this Brief, are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

The Appeal Brief contains each of the topics required by 37 C.F.R. §1.192 and M.P.E.P. § 1206, presented herewith and labeled appropriately.

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I. REAL PARTY IN INTEREST

The real party in interest for the present application is John M. Shanahan of 200 South Bay Front, Balboa Island, California 92662.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences related to the present application which will directly affect or be directly affected by or have a bearing on the Board's decision in this Appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 14 claims pending in application.

B. Current Status of Claims

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-14
4. Claims allowed: None
5. Claims rejected: 1-14

C. Claims On Appeal

Accordingly, Appellant hereby appeals the final rejection of claims 1-14. Pending claims 1-14 are set forth in the Appendix, attached herewith.

IV. STATUS OF AMENDMENTS

The Patent Office mailed the first Office Action on the merits on June 28, 2002 (paper no. 3), wherein the Examiner rejected pending claims 1-14. Claims 1, 3-6, 8, 10, 11, 13 and 14 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mueller (U.S.

Patent No. 3,770,278). Claims 2, 7, 9 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Reynolds (U.S. Patent No. 3,768,813).

Applicant responded on September 26, 2002 by filing an amendment (paper no. 4) that amended Claim 11. Additionally, Appellant submitted remarks distinguishing the invention defined by the pending claims from that taught by Mueller, and the combination of Mueller and Reynolds.

A second office action (paper no. 5), made final, was mailed on December 12, 2002. In this Office Action, the again Examiner rejected claims 1, 3-6, 8, 10, 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Mueller. Claims 2, 7, 9 and 12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Reynolds.

In response to the Final Office Action, on February 4, 2003 Applicant's representative had a telephone interview with the Examiner. The substance of the interview was incorporated in a Request for Reconsideration which was filed with the Patent Office on February 10, 2003 (paper no. 6). In essence, the Request for Reconsideration presented additional remarks concerning the differences between the prior art references relied on by the Examiner and the claimed invention.

The Examiner responded to the Request for Reconsideration with an Advisory Action mailed March 11, 2003 (paper no. 7). In the Advisory Action, the Examiner indicated that he would not consider key limitations of the claims. Consequently, claims 1-14 stand rejected under 35 U.S.C. § 103(a).

V. SUMMARY OF INVENTION

As the title of the application indicates, the present invention is directed a card game having predetermined hands in a fortune cookie. More specifically, the card game includes at least one strip of paper 12 embedded in the fortune cookie 10. The strip of paper 12 is separable from the fortune cookie 10 once the fortune cookie has been opened.

Figures 2 and 3 from Appellant's application is shown below. As illustrated, the strip of paper 12 includes at least one card 18 that bears the indicia of one denomination 16

and one suit 14. Alternatively, the strip of paper 12 may include as many cards as required to play a particular card game. Further, as shown in Figure 3, a dividing line 20 is provided between adjacent cards 18. The dividing line 20 is perforated to allow the selective separation and removal of individual cards 18 from the strip of paper 12. *See, Paragraphs [0010-0013].*

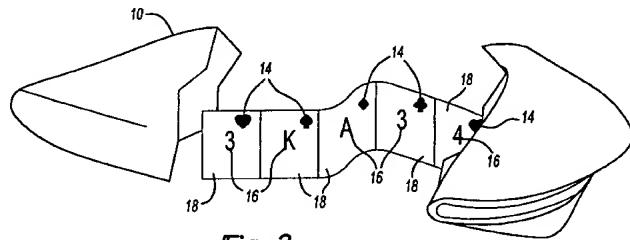


Fig-2

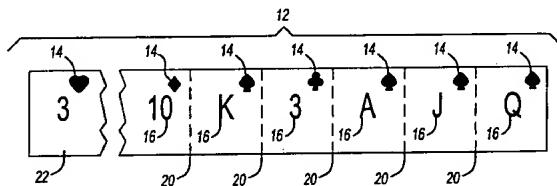


Fig-3

VI. ISSUES

In the Final Office Action of December 12, 2002, the Examiner rejected claims 1-14 under 35 U.S.C. §103(a). The issues presented on appeal are:

- a.) whether claims 1, 3-6, 8, 10, 11, 13 and 14 are unpatentable under 35 U.S.C. §103(a) over Mueller; and
- b.) whether claims 2, 7, 9 and 12 are unpatentable under 35 U.S.C. §103(a) over Mueller in view of Reynolds.

VII. GROUPING OF CLAIMS

For purposes of the issues presented by this Appeal only, and without conceding the teachings of any prior art reference, claims 1, 3-5, 11, 13 and 14 stand or fall together as

a group. Claims 6, 8, and 10 stand or fall together as a group. Claims 2, 7, 9, and 12 stand or fall as a group.

In Section VIII below, Applicant has included arguments supporting the separate patentability of each claim group as required by M.P.E.P. §1206.

VIII. ARGUMENTS

A. The §103 Rejection of Claims 1, 3-5, 11, 13 and 14 over Mueller Should Be Reversed Because the Prior Art Fails To Teach Or Suggest A Pre-Dealt Card Game Having At Least One Hand Unit

Claims 1, 3-5, 11 13, and 14 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Mueller (U.S. Patent No. 3,770,278). Independent claims 1 and 11 recite:

1. A pre-dealt card game comprising at least two separate hand units of cards, with each said hand unit comprising:

a strip of paper displays all said cards in said hand unit;

a fortune cookie;

wherein said strip of paper displays at least one said card bearing the visible indicia of one predetermined suit and denomination; and

wherein said strip of paper is located at least partially inside said fortune cookie.

11. A novelty item comprising:

at least one strip of paper displaying one hand unit of cards, with each said hand unit comprising one or more cards with each said card bearing the indicia of one suit and one denomination to define a card game hand; and

a fortune cookie containing said strip so that said indicia are not visible without breaking said fortune cookie.

The Examiner relies on Mueller as teaching the following:

Mueller teaches a strip in a fortune like cookie and strip having printed matter (Fig. 3). Mueller teaches all limitations of these claims except that it does not teach predetermined denomination and suit as indicia. The only difference between applicant's strip and Mueller resides in the meaning and information conveyed by the printed matter. Such differences are considered unpatentable,

Ex parte Breslow, 192 USPQ 431. In order to create a variation, it would have been obvious to print predetermined denomination or any other theme related indicia. (paper no. 5, pg. 2, ¶1).

“A *prima facie* case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art.” *See In re Bell*, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993)(quoting *In re Rinehart*, 189 USPQ 143, 147 (CCPA 1976)). Here, there is no suggestion in the prior art or reasoning in the rejection that discloses “a card game” or a “novelty item” that includes a strip of paper at least partially located in a fortune cookie where the strip of paper includes at least one card having the visible indicia of one predetermined suit and denomination.

Indeed, the Examiner concedes that Mueller is lacking such a teaching:

Mueller teaches all limitations of these claims except that it does not teach predetermined denomination and suit as indicia. (Paper no. 5, pg. 2, ¶1).

In fact, Mueller is not relevant to the claimed invention. Mueller is not directed to a card game or a novelty item that includes strips of papers having playing cards printed thereon with different suits and denominations. Instead, Mueller is directed to a word puzzle game that includes a predetermined set of fortune cookies, each of the fortune cookies having strips of paper that each bear a segment of a written composition (Col. 2, lines 18-20). The set of cookies are placed in a package at random, and when opened by the players, must be arranged in a specified order to recreate the composition or story (Col. 2, lines 20-23). The players of the game disclosed in Mueller must read the various composition segments and guess the proper order of the segments to properly create the story or composition. This is the only embodiment shown in Mueller.

In contrast to Mueller, Appellant's card game and novelty item includes a strip of paper having playing cards. As admitted by the Examiner, playing cards are not taught by Mueller. Nor are the limitations of the depend claims taught or suggested by Mueller. More specifically, Mueller does not teach or suggest the limitation that no two cards in the same hand unit bear both the same suit and the same denomination of any other card on the same strip of paper (claims 3 and 13). Nor is the limitation that no card in any hand unit displays both the same suit and denomination of any other card in a concurrent hand unit (claims 4 and 14). Further, Mueller makes clear that each fortune cookie includes only a single strip of material. This is also unlike the claimed invention where each fortune cookie may include more than one strip of paper (see claims 5 and 11). Finally, there is clearly no obvious correlation between a word puzzle game that requires a predetermined set of fortune cookies and a card game where the fortune cookies could be selected at random.

B. *Ex parte Breslow* Does Not Establish a Prima Facie Case of Obviousness

In the final Office Action, the Examiner relies upon *Ex parte Breslow* in an attempt to overcome the admitted deficiencies of the prior art. The Examiner admits that Mueller fails to teach or suggest cards having predetermined suits and denomination. However, despite the complete lack of the claimed cards having predetermined suits and denominations, the Examiner simply states (without any reference to the prior art) that "in order to create a variation [of Mueller], it would have been obvious to print predetermined denomination or other theme related indicia. One of ordinary skill in the art at the time the invention was made would have printed suit and denomination on the strip." (paper no. 5, pg. 2, ¶1).

However, the situation that was present in *Ex parte Breslow* is completely different from the present situation. In *Breslow*, the both the claimed invention and the prior art relied upon by the examiner in rejecting the claims involved simply “a game device” that both included a game board, a chance device, and a plurality of sets of cards. While the two board games were based on two different themes, they were in essence the same type of game, both structurally and functionally.

Contrary to the situation in *Breslow*, Applicant’s invention does not merely modify the theme of the word segments disclosed in Mueller. Mueller simply does not teach, disclose or even suggest providing a card game that includes cards having a predetermined suit and denomination printed thereon, as positively claimed by Appellant in claims 1 and 11. Indeed, in the present case, Applicant’s invention involves a card game that is clearly different from that which is disclosed in Mueller. A word game where segments of successive fortune cookies must be strung together in a particular order by all the players working together is clearly not the same type of game as Appellant’s card game where players have randomly selected “cards” and can play against one another.

C. The §103 Rejections of Claims 6, 8, and 10 Should be Reversed Because Mueller Fails to Teach or Suggest A Pre-Dealt Poker Game That Includes A At Least Two Separate Hand Units

Claims 6, 8 and 10 also stand rejected under 35 U.S.C. §103(a) as being unpatentable in view of Mueller. Independent claim 6 recites:

6. A pre-dealt poker game comprising at least two separate hand units of cards, with each said hand unit comprising:

a strip of paper bearing at least five cards, said cards bearing the visible indicia of one predetermined suit and denomination;

a fortune cookie;

wherein no two cards in said unit are identical in suit and denomination; and

wherein said strip of paper is located at least partially inside said fortune cookie so that the suit and denomination of card are not visible without breaking said fortune cookie.

The Examiner, without any elaboration, simply stated that Mueller teaches all of the limitations of these claims (paper no. 5, pg. 2, ¶1). However, as set forth in greater detail above, Muller clearly is not directed to a “pre-dealt poker game” that includes a strip of paper bearing at least five cards, where each of the cards bear one predetermined suit and denomination. Instead, Mueller only teaches a word game that includes a set of fortune cookies having a predetermined number of cookies, each cookie containing a strip of paper having a specific word segment of a story or composition, where each segment must be placed in a specific order to tell a story or to complete a word composition. Nor does Mueller teach or disclose a game having a winning hand unit, as positively claimed in claim 10. Indeed, Mueller requires all of the players of its game to work together in combining their respective strips of paper in a particular order to define a specific story or composition.

D. The §103 Rejections of Claims 2, 7, over Mueller in view of Reynolds Should be Reversed Because Mueller Teaches Away From Separation of Portions of the Strips of Paper

Claims 2 and 7 both require that each hand unit includes at least two adjacent cards that are separated by a perforation to allow selective separation of each individual card. As admitted by the Examiner, this feature is clearly absent from Mueller. To make up for the deficiencies in Mueller, the Examiner relies on Reynolds. Reynolds simply teaches a base card having removable tabs, while Mueller teaches a single sheet of paper having has a

printed word segment that cooperates with other word segments to create a specific story or written composition. There is simply no motivation to combine the two references.

In fact, the only document of record that teaches or suggests the features of the claimed invention is Appellant's specification. It is well settled that Appellant's specification can not be used as a guide for selecting and combining prior art references. *See Grain Processing Corp. v. American Maize-Products Co.*, 5 USPQ2d 1788, 1972 (Fed. Cir. 1988). Thus, Mueller, alone or in combination with Reynolds is not proper.

Moreover, Mueller teaches away from such a combination. Indeed, Mueller specifically requires that all word segments from all of the fortune cookies must be joined together to complete the game. Mueller does not teach separating the individual word segments or even discarding some word segments. Therefore, as Reynolds teaches separation of strips of paper and Mueller teaches away from separation of portions of the word segments, there is no motivation to combine the references. Appellant, therefore, respectfully requests reversal of the rejection of claims 2, 7, 9 and 12 under 35 U.S.C. § 103(a).

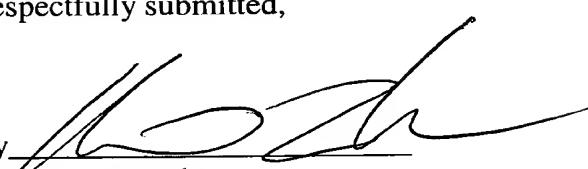
For all the above reasons, Appellant submits that claims 1-14 are allowable over Mueller, alone and in combination with Reynolds, and therefore respectfully requests that the §103(a) rejections be reversed and withdrawn.

IX. CLAIMS INVOLVED IN THE APPEAL

A copy of the claims involved in the present appeal is attached hereto as Appendix A.

Dated: July 10, 2003

Respectfully submitted,

By 

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Registration No.: 41,212

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/888,145

1. A pre-dealt card game comprising at least two separate hand units of cards, with each said hand unit comprising:

a strip of paper displays all said cards in said hand unit;

a fortune cookie;

wherein said strip of paper displays at least one said card bearing the visible indicia of one predetermined suit and denomination; and

wherein said strip of paper is located at least partially inside said fortune cookie.

2. The card game in claim 1, wherein said hand unit contains at least two adjacent cards displayed on said strip of paper and between every two adjacent cards is a perforation across said strip of paper to allow selective separation of each of said card on said strip of paper.

3. The card game in claim 1, wherein no two cards in said strip of paper bear both the same suit and the same denomination of any other card on said strip of paper.

4. The card game in claim 3, wherein no card in any said hand unit displays both the same suit and same denomination of any other card in a concurrent hand unit.

5. The card game in claim 1, wherein each fortune cookie includes more than one said strip of paper.

6. A pre-dealt poker game comprising at least two separate hand units of cards, with each said hand unit comprising:

a strip of paper bearing at least five cards, said cards bearing the visible indicia of one predetermined suit and denomination;

a fortune cookie;

wherein no two cards in said unit are identical in suit and denomination; and

wherein said strip of paper is located at least partially inside said fortune cookie so that the suit and denomination of card are not visible without breaking said fortune cookie.

7. The card game in claim 6, wherein between every two adjacent cards is a perforation extending across said strip to allow selective separation of each card on said strip.

8. The card game in claim 6, wherein no two cards in any concurrent hand unit display both the same suit and the same denomination.

9. The card game in claim 7, wherein players discard a predetermined number of cards before disclosing their hand to any other players to determine a winner.

10. The card game in claim 8, wherein a person having a winning hand unit has a meal paid for by the persons having losing hand units.

11. A novelty item comprising:

at least one strip of paper displaying one hand unit of cards, with each said hand unit comprising one or more cards with each said card bearing the indicia of one suit and one denomination to define a card game hand; and

a fortune cookie containing said strip so that said indicia are not visible without breaking said fortune cookie.

12. The novelty item in claim 11, wherein every two adjacent said cards are separated by a perforation across said strip of paper which allows each said card to be selectively separated from said strip.

13. The novelty item in claim 11, wherein no two said cards on any said strip of paper bear the same indicia of suit and the same indicia of denomination.

14. The novelty item in claim 13, wherein no two said cards on any concurrent hand bear the same indicia of suit and the same indicia of denomination.

TRANSMITTAL OF APPEAL BRIEFDocket No.
65043-0038

In re Application of: John M. Shanahan

Application No. 09/888,145	Filing Date June 22, 2001	Examiner V. Mendiratta	Group Art Unit 3711
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Invention: A CARD GAME WITH PREDETERMINED HANDS IN A FORTUNE COOKIE

TO THE COMMISSIONER OF PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed: April 10, 2003.

The fee for filing this Appeal Brief is 160.00.

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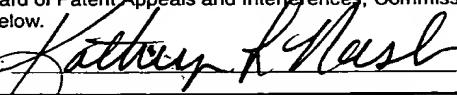
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Dated: July 10, 2003

Signature



(Kathryn L. Nash)